



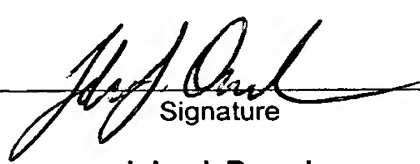
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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>FJ-2001-041-US</b>			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR on _____ Signature _____ Typed or printed name _____		Application Number <b>10/058,924</b>		Filed <b>January 30, 2002</b>	
		First Named Inventor <b>Hisayoshi Tsubaki</b>			
		Art Unit <b>2625</b>		Examiner <b>Perungavoor, S. V.</b>	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.  I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>46,672</b> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ <div style="text-align: right;"> _____ Signature <b>John J. Dresch</b> _____ Typed or printed name <b>703-761-4100</b> _____ Telephone number <b>May 1, 2006</b> _____ Date</div>					
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.					

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No. FJ-2001-041-US  
(MAS.012)



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Hisayoshi Tsubaki

Serial No.: 10/058,924

Group Art Unit: 2625

Filed: January 30, 2002

Examiner: Perungavoor, Sathyanaraya V.

For: IMAGE RECORDING METHOD AND SYSTEM, IMAGE TRANSMITTING  
METHOD, AND IMAGE RECORDING APPARATUS

Honorable Commissioner of Patents  
Alexandria, VA 22313-1450  
**Box AF**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Prior to developing a formal Appeal Brief, Appellants submit the following argument for review by more experienced Examiners under the pilot Pre-Appeal Brief Conference. Appellants concurrently file herewith a Petition for Extension of Time, for a one-month extension of time, and a Notice of Appeal.

Appellants hereby request that the Conference attendees refer to the full argument of Appellants on pages 17-30 of the Response filed Under 37 C.F.R. § 1.116, filed on February 16, 2006, and do not herein repeat these arguments in their entirety.

In addition to these arguments, Appellants respectfully submit that the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a) as being unpatentable over McDonald, Wang, Kuperstein, and TIFF. Thus, Appellant submits that a *prima facie* case of obviousness clearly has not been properly established at least with respect to claims 8, 18, and 22 of the present application.

Instead, the Examiner states only that it would have been obvious to combine McDonald, Wang, Kuperstein, and TIFF “*to record the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded, motivation being the ability to sort and process digital images in a computer*” (see Office Action mailed November 29, 2005, at page 10, lines 10-14).

However, no citation to any of the cited references has been provided for such stated motivation. Thus, Appellants respectfully submit that the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a).

Hence, the Examiner has clearly failed to establish a *prima facie* case of obviousness.


In view of the foregoing arguments, along with those arguments currently of record in the Response Under 37 C.F.R. § 1.116 filed on February 16, 2006, Appellants submit that the prior art rejections currently of record fail to meet the Examiner’s initial burden of a *prima facie* rejection, since the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a) as being unpatentable over McDonald, Wang, Kuperstein, and TIFF.

Accordingly, Appellants respectfully submit that claims 1-41, all the claims presently pending in the application, are clearly patentable and are in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee’s Deposit Account No. 50-0510.

Respectfully Submitted,

Date: May 1, 2006

  
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